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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,615	08/31/2001	Junichi Kimura	520.40577X00	7490
20457	7590	12/21/2004	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889			SHINGLES, KRISTIE D	
		ART UNIT	PAPER NUMBER	
		2141		

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/942,615	KIMURA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kristie Shingles	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 August 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 August 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

*Claims 1-10 are pending.*

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. JP 2001-102922 filed on 4/2/2001.

### ***Abstract***

2. The abstract of the disclosure is objected to because it exceeds 1 paragraph, and uses legalese: "thereby" and "wherein". Correction is required. See MPEP § 608.01(b).

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **48, 60-65, 71-73, 75, 121, 124, 126, 127, 129, 133, 162, 165, 167, 180, 1001, 5104, 5105, 5108 and 5109.** Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The

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replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **2100**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by *Sahai et al* (USPN 6,594,699).

a. **Per claim 1**, *Sahai et al* teach a media distribution system having a server which distributes media information transmitted by a first terminal to a second terminal, said server comprising:

- means for acquiring media decoding capability of said second terminal (**Col.2 Lines 19-28, Col.3 Lines 15-60 and Col.4 Lines 32-63; server acquires the processor capabilities and media decoding capabilities of the destination/second terminal**); and
- means for converting said media information into media information to be output according to said media decoding capability acquired (**Col.2 Lines 8-15, Col.4 Lines 9-63 and Col.5 Line 4-Col.6 Line 53; server is able to convert the media data into a format compatible with the media decoding ability of the destination/second terminal**).

b. **Claim 2** contains limitations that are substantially similar to claim 1 and is therefore rejected under the same basis.

c. **Per claim 7**, *Sahai et al* teach a multi-media conversion server comprising:

- means for receiving video information addressed to a second terminal from a first terminal (**Figure 2, Col.3 Lines 5-19, Col.4 Lines 9-63 and Col.6 Lines 12-16; media server may receive media/video data from the server addressed to the user/second terminal**);

- means for acquiring video format information that can be received and decoded by said second terminal (**Col.3 Lines 23-60, Col.4 Lines 32-43, Col.5 Lines 36-46 and Col.6 Lines 9-16; the media server acquires the media format data from the server that received the device capability and media formatting information of the user's device—device capabilities comprise video decoders, audio decoders, hardware such as display screens of computing devices, etc;**);
- means for comparing a video format of said received video information with a video format that can be received and decoded by said second terminal (**Col.3 Line 50-Col.4 Line 56 and Col.5 Line 47-Col.6 Line 21; the server and media server both use a variety of media formats and compares them with the one most compatible and appropriate with the media decoding format of the user's terminal and chooses that one format for output or playback on the user's terminal;**);
- if any corresponding video format which allows the second terminal to receive and decode the received video information is not available as a result of said comparison, means for selecting one video format that can be received and decoded by said second terminal, and converting said entered video information into that of the video format thus selected (**Col.6 Lines 17-42; video clips are converted and stored in multiple formats so that the one that most satisfies the user's preference and device capabilities may be selected;**) and
- means for transmitting said converted video information to said second terminal (**Col.6 Lines 42-49; once the proper formatting and conversion has taken place the media/video is transferred to the user).**

d. **Claim 8** contains limitations that are substantially equivalent to claims 2 and 7 and is therefore rejected under the same basis.

7. Claims 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by *Chen et al* (USPN 6,553,100).

a. **Per claim 3,** *Chen et al* teach a multi-media conversion server comprising:

- means for receiving character information addressed to a second terminal by a first terminal (**Col.5 Lines 21-67; the alert detection device comprises a communication format converter implemented as part of an intelligent processor may be used on a server, furthermore, the alert detection device may receive indicators from the alert event detectors for alert text messages addressed to clients**);
- speech signal conversion means for converting said character information into a speech signal (**Col.6 Lines 40-43; implements text-to-speech conversion**);
- video signal synthesis means for synthesizing a video signal corresponding to said speech signal (**Col.6 Lines 40-50; implements audio and video synthesis for format conversion**);
- speech synthesis means for encoding said speech signal in one of formats which allow said second terminal to receive and decode such signal (**Col.6 Lines 33-67; implements audio synthesis for format conversion based on the device's capabilities**);
- video encoding means for encoding said video signal in one of formats which allow said second terminal to receive and decode such signal (**Col.6 Lines 33-67; implements video synthesis for format conversion based on the device's capabilities**); and
- means for adding the synthesized speech stream and the synthesized video stream to said character information, and sending such streams to said second terminal (**Col.5 Line 51-Col.6 Line 15, Col.6 Lines 45-67 and Col.8 Line 54-Col.9 Line 7; the synthesized alert message in the forms of text, audio and/or video will be sent to the client's device**).

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b. **Per claim 4,** *Chen et al* teach the multi-media conversion server of claim 3, further comprising means for acquiring format information that can be received and decoded by said second terminal, wherein said speech synthesis means and said video synthesis means are configured to perform synthesizing operations using said format information (**Col.6 Line 54-Col.7 Line 63; the communication format converter may alert the user via the appropriate device as specified in the user's profiles, which determines the what formatting and form of synthesis should occur based on the device's characteristics.**)

c. **Per claim 5,** *Chen et al* teach the multi-media conversion server of claim 3, further comprising means for presenting a plurality of speech types to be converted and a plurality of video types to be synthesized to said first terminal, and instructing to select and specify each one type from among the speech and video types; wherein said speech synthesis means converts said speech encoding information and the video encoding information thus selected in the above into a speech signal according to the content of the selected speech selection information of a reception signal attached to character information, and wherein said video synthesis means synthesizes said video signal selected in the above (**Col.3 Line 43-Col.5 Line14, Col.8 Lines 54-67 and Col.10 Lines 37-43; the alerting means may comprise a variety of voice, audio, video, or text types according to the user's preference, profile and device characteristics).**)

d. **Claim 6** contains limitations that substantially similar to claims 3 and 1 and is therefore rejected under the same basis.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Sahai et al* (USPN 6,594,699) in view of *Jayant et al* [US 20020028024].

a. **Per claim 9,** *Sahai et al* teach the multi-media conversion server of claim 1, yet fails to distinctly teach in a multi-media conversion server of claim 1, a multi-media conversion service characterized in that a conversion fee that is determined based on the combination of an input media information type with an output media information type is charged to a transmitter. However, *Jayant et al* teach implementing a fee dependant on the type of encoding service requested by the client before displaying on the client's terminal [**paragraphs 0078-0081**].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Sahai et al* and *Jayant et al* for the purpose of charging a fee for the multi-media's format conversion's quality of service; because it would financially benefit and compensate the conversion providers for their services while funding the system so for it to afford enhancements and improvements to its conversion and synthesizing services.

b. **Claim 10** is substantially similar to claim 9 and is therefore rejected under the same basis.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. *Newlin* (USPN 5,774,857) discloses conversion of communicated speech to text for transmission as RF modulated base band video.
- b. *Tilt* (USPN 6,029,194) discloses an audio/video media server for distributed editing over networks.
- c. *Baumeister et al* (US 20010016869) disclose a method and system for integration of new media into character-oriented applications.
- d. *Fujinami et al* (USPN 6,697,566) disclose an encoded signal characteristic point recording apparatus.
- e. *Hosono et al* (USPN 5,392,165) disclose an apparatus for recording audio and video signals.
- f. *Katto* (USPN 6,072,832) discloses an audio/video/computer graphics synchronous reproducing/synthesizing system and method.
- g. *Crandall* (US 20020013820) discloses private performance transmission.
- h. *Oashi et al* (USPN 6,427,150) disclose a system and method for digital data communication.
- i. *Ohto et al* (USPN 6,327,616) disclose a terminal device in document information communication system.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles

Examiner

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kds



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USPTO - GOVT PATENT EXAMINER